

UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF NEW YORK

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NATIONWIDE SALES AND SERVICES INC.
and IMIG, INC.,

Plaintiffs,

- against -

STEEL CITY VACUUM COMPANY, d/b/a Steel
City Vacuum Company Inc.

Defendant.
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**ORDER ADOPTING REPORT
AND RECOMMENDATION**

2:16-cv-6223 (DRH) (ST)

HURLEY, Senior District Judge:

Presently before the Court is the Report and Recommendation of Magistrate Judge Steven Tiscione, dated February 16, 2021 (the “R&R”) [DE 72], recommending that the Court grant Plaintiffs Nationwide Sales and Services Inc. and IMIG, Inc.’s (together, “Plaintiffs”) motion for judgment on the pleadings against Defendant Steel City Vacuum Company (“Defendant”). More than fourteen (14) days have passed since service of the R&R and no objections have been filed.

Pursuant to 28 U.S.C. § 636(b) and Federal Rule Civil Procedure 72, this Court has reviewed the R&R for clear error. Plaintiffs’ motion for judgment on the pleadings addressed (i) Defendant’s two counterclaims which “sought unenforceability of [Plaintiffs’ patents] due to patent misuse”¹ and (ii) Defendant’s assertion “that this matter is an exceptional case” entitling Defendant “to an award of attorneys’ fees incurred in connection with this action.” R&R at 2. Judge Tiscione

¹ Defendant had originally asserted four counterclaims. [DE 22]. At the time of the R&R, only two remained; the others were previously dismissed via stipulation. See Stipulation, Order & Certification Pursuant to Fed. R. Civ. P. 54(b) [DE 62].

found that (i) “any alleged [patent] misuses ha[d] already been purged,” meaning that Defendant’s “claims for unenforceability no longer provide grounds for relief,” (ii) Plaintiffs were “not required to challenge [Defendant’s] exceptional case allegation” in their motion, and (iii) no precedent supported denying “the appropriate dismissal of a misuse [counterclaim]” so Defendant may take discovery “in support of a future motion for attorneys’ fees.” R&R at 7, 9, 10.

Having found no clear error, the Court concurs in both the R&R’s reasoning and its result. Accordingly, this Court adopts the February 16, 2021 R&R of Judge Tiscione as if set forth herein. Plaintiffs’ motion for judgment on the pleadings as to Defendant’s patent misuse counterclaims is GRANTED.

SO ORDERED.

Dated: Central Islip, New York
March 16, 2021

s/ Denis R. Hurley
Denis R. Hurley
United States District Judge